

REMARKS

This is in response to the Office Action mailed on 14 May 2007. Claims 1-11, and 13-14 are pending in the application, and Claims 1-11, and 13-14 have been rejected.

By this Response and Amendment claims 1-11, and 13-14 are presented.

No new matter has been added.

In view of the amendments above and the remarks below, Applicants respectfully request reconsideration and allowance of the subject Application. Accordingly, Claims 1-11, and 13-14 are pending as listed above.

37 CFR §1.131 Affidavit of Sandra Thuel

Applicant respectfully requests that the affidavit of Ms. Sandra Thuel, submitted herewith pursuant to Rule 131 and attached hereto, be admitted to show prior date of invention.

Applicant submits herewith a declaration under 37 CFR §1.131 and supporting documentation to evidence that the invention was conceived in the United States prior to the February 1, 2000 filing date of U.S. Patent No. 6,707,809, issued to Warriar et al. (hereinafter "Warrior"). Accordingly, the Warriar reference should be removed as a reference because it is not prior art.

When any claim of an application is rejected, a qualified party may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference on which the rejection is based. 37 CFR 1.131. An affidavit showing prior invention may be timely presented after final rejection in certain cases. MPEP 715.09.

In the present application, prosecution was transferred from one law firm to another; therefore, prosecution was not within the control of one entity for the length of prosecution. As prosecution proceeded with an RCE numerous attempts were made to contact inventors in the application, however, several had left employment with Lucent Technologies (assignee of application No. 09/662,531) until contact was made with Ms. Sandra Thuel, one of the co-inventors. Upon discussions of the invention it became apparent that the invention was actually conceived of well prior to the cited reference's filing date; furthermore, Ms. Thuel had evidence of the continued diligence of the inventors until a time prior to the filing of the present application. Thus, a more timely affidavit concerning prior invention was not possible in this case and Applicant respectfully requests that the attached affidavit be admitted as timely presented as allowed for under MPEP 715.09.

The attached affidavit seeks to demonstrate the following: that the invention was conceived of prior to the effective date of the cited reference coupled with diligence from a time prior to the prior art date of the cited reference to a subsequent filing of the application. The affidavit includes, as exhibits, computer files (emails) and a text document showing conception of the invention and diligence prior to filing of the application.

Evidence in support of an earlier date of conception than the Warrier reference is submitted herewith and includes the following exhibits:

1. Transient Tunneling manuscript authored by Sandra Thuel, which was completed and distributed to co-inventors for feedback before January 25, 2000. (See also email confirmation of date of distribution) The

manuscript was written over a course of time beginning in November of 1999.

2. Email threads that show communications regarding the invention, which further show diligence on the part of the inventors from a date prior to the date of the Warrier reference, until the time of subsequent filing for patent protection.

Based on the foregoing evidence and affidavit, it is respectfully asserted that Applicant had possession of the claimed invention prior to February 1, 2000, and is therefore able to swear behind the reference (Warrier) cited in the rejection.

About the Invention

The claimed invention is directed to a method of enabling a portable and/or mobile host, using a standard Mobile IP protocol, to dynamically acquire a home address from Dynamic Host Configuration Protocol servers in the home network of the mobile host, in a manner consistent with the Dynamic Host Configuration Protocol (hereinafter DHCP) upon powering up in a foreign network.

Ordinarily, mobile hosts that power up in a foreign network cannot contact addressing servers in their home network. Dynamic home addressing, as required when a mobile host powers up in a foreign network, is not specified in the Mobile-IP standard. Therefore, a mobile host that powers up in a foreign network with no home address cannot contact addressing servers in its home network through conventional DHCP broadcasting. Any upstream broadcast messages sent from the mobile host to the home network will be received by a local server

or relay in the foreign network, which may offer an address from its own lease pool, but not the host's home network.

The present claimed invention provides a solution for this problem using transient tunneling – a novel two-stage addressing procedure for mobile hosts that power up in a foreign network. A bootstrapping agent – an addressing element that is co-located with a Mobile-IP home agent – facilitates the creation of the temporary tunnel over which standard DHCP transactions can take place. The temporary tunnel allows DHCP transactions to occur between the home network and foreign network in an efficient manner with reduced latency times – as compared to non-encapsulated IP tunneling techniques over the Internet.

The method allows the mobile host to contact addressing servers in its home network, even as it powers up in a foreign network.

Rejection under 35 U.S.C. § 103(a)

Claims 1-11, 13 & 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,510,153 issued to Inoue et al. (hereinafter, Inoue) in view of U.S. Patent No. 6,707,809 issued to Warriar et al. (hereinafter Warriar) In view of the §131 Affidavit declaring an earlier date of invention, Warriar is removed as prior art. As such, Applicant respectfully requests withdrawal of the § 103(a) rejection.

Inoue is directed to various mobile IP communications schemes in which a mobile computer acquires addresses when the mobile computer is moving locations, such as from a home network to a foreign network. (See, i.e., Inoue,

Summary of the Invention). In one of the examples disclosed in Inoue, the mobile computer is turned-on at a visiting site (Inoue, Col. 16, lines 4-24), and a DHCP Home Address is acquired from the mobile computer's home network, if available (Inoue, Col. 16, lines 31-68, Col. 17, lines 1-11). Communication between the mobile computer from the foreign network, and the home network occurs through a series of messages transmitted over the Internet and the home network (See, e.g., Inoue Fig. 15). That is, once movement is detected indicating the mobile device is in a foreign network, such as through an advertisement broadcast by the mobile computer over the Internet (Inoue, Col. 12, lines 20-28), then the home address is acquired through a series of messages transmitted over the Internet including broadcasting in the home network requesting the home address (Inoue, Col. 16, lines 64-67).

Inoue fails to disclose using a temporary tunnel to obtain configuration data including a permanent home address from the home network of the mobile device as defined by Applicants' claimed invention. (See Office communication, Page 2 Number 7) Inoue is devoid of any teaching or suggestion of setting up a temporary tunnel between the foreign network and home network for the purpose of increasing data transmission efficiency and hence speed of acquiring a home address from the home network. Thus Inoue fails to teach the bootstrapping agent and transient tunnel as required by Applicants' Claim 1.

Furthermore, Inoue fails to disclose establishing a transient tunnel between the mobile IP home agent and mobile foreign agent associated with the mobile host while on the foreign network, as required by Applicants' Claim 9. (See Office communication, Page 4 Number 16) Inoue also fails to teach establishing a

transient bi-directional link between the host and the mobile IP home agent using the M-IP protocol and the temporary home address, as required by Applicants' Claim 10. (See Office communication, Page 5 number 19) Nor does Inoue teach setting up a temporary IP tunnel as required by Applicants' Claims 13 and 14. (See Office communication Page 6 Number 23 and Page 7 Number 26)

Conclusion

In view of the foregoing amendments, remarks, and affidavit, Applicant submits that claims 1-11, and 13-14 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. If any issues remain that preclude issuance of this application, the Office is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully submitted,

WERNER & AXENFELD, PC

Dated: 10 Oct. 2007
P.O. BOX 1629
West Chester, PA 19380
(610) 701-5810

By Kristin Mazany Nevins
Kristin Mazany Nevins
Reg. No. 56,775
Attorney for Applicants